



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/885,005	06/21/2001	Kazuo Kuroda	1767-83	3546
23117 7590 07/06/2009 NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203				
EXAMINER				
SHIBRU, HELEN				
ART UNIT		PAPER NUMBER		
2621				
MAIL DATE		DELIVERY MODE		
07/06/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/885,005

Applicant(s)

KURODA ET AL.

Examiner

HELEN SHIBRU

Art Unit

2621

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 12, 33, 42 and 49-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1, 12, 33, 42, 49-58 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Response to Amendment

1. The amendments, filed 04/09/2009, have been entered and made of record. Claims 1, 12, 33, 42, 49-58 are pending, claims 2-11, 13-32, 34-41, and 43-48 are cancelled. However based on the amendment filed on 04/09/2009 claims 1, 12, 33, 42, 49-58 are restricted. See below.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 1. Claims 1, 12, 33, 42, 56-57 and 58, drawn to an information outputting apparatus for reading out main information from a recording medium and outputting the main information from a recording medium and outputting the main information to an external apparatus to record main information in an optical recording medium in the external apparatus comprising: "an outputting device for outputting the main information including a plurality of partial information and recording position information showing a recording position of the partial information on the optical recording medium on which the partial information is to be recorded,... wherein in each session of outputting the whole of the same main information, the outputting device sequentially outputs the partial information and the recording position information in accordance with an order of recording or reproducing, and wherein the recording position information comprises sector address information set in advance in the optical recording medium", classified in class 386, subclass 88.

- II. Claims 49-52 and 54, drawn to an information recording apparatus for receiving partial information of main information outputted repeatedly and address information indicating a position on an information recording medium in which the partial information is to be recorded via network comprising: “an address information receiving device for receiving the address information corresponding to the partial information; ... a detecting device for detecting completion of recording the whole of the partial information of the main information; a stop controlling device for stopping recording of the partial information in accordance with the detection by the detecting device.”, classified in class 386, subclass 124.
- III. claims 53 and 55, drawn to an information recording apparatus for recording partial information outputted from an information outputting apparatus comprising: “a first outputting device for outputting the partial information of main information; a second outputting device for outputting order information indicating a recording order of the partial information on the information recording medium in accordance with time series of reproduction; and a controlling device for causing the first outputting device and the second outputting device to repeat their outputs in a plurality of cycles as one cycle is the output of the main information, the information recording apparatus comprising: ... an order information receiving device for receiving the order information corresponding to the partial information; a recording device for recording the partial information corresponding to the order information in accordance with the order information; a detecting device for detecting completion of recording the

whole of the partial information of the main information; a stop controlling device for stopping recording of the partial information in accordance with the detection by the detecting device,” as classified in class 386 subclass 68.

3. The inventions are distinct, each from the other because of the following reasons:

groups I-III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case the information outputting apparatus of group I does not require the feature of “an information recording apparatus for receiving partial information of main information outputted repeatedly, and a detecting device for detecting completion of recording the whole of the partial information of the main information; a stop controlling device for stopping recording of the partial information in accordance with the detection by the detecting device” as recited in claim 49, and the feature of “a first outputting device for outputting the partial information of main information; a second outputting device for outputting order information indicating a recording order of the partial information on the information recording medium in accordance with time series of reproduction; and a controlling device for causing the first outputting device and the second outputting device to repeat their outputs in a plurality of cycles as one cycle is the output of the main information, and a detecting device for detecting completion of recording the whole of the partial information of the main information; a stop controlling device for stopping recording of the partial information in accordance with the detection by the detecting device” as recited in claim 53.

Similarly the information recording apparatus for receiving partial information as claimed in group II, claim 49 for example, does not require the feature of “an outputting device for **outputting the main information including a plurality of partial information** and **recording position information** showing a recording position of the partial information on the optical recording medium on which the partial information is to be recorded,... wherein in each session of outputting the whole of the same main information, the outputting device sequentially outputs the partial information and the recording position information in accordance with an order of recording or reproducing, and **wherein the recording position information comprises sector address information set in advance in the optical recording medium**” as recited in group I, claim 1 for example, and “an order information receiving device for receiving the order information corresponding to the partial information; a recording device for recording the partial information corresponding to the order information in accordance with the order information” as claimed in claim 53.

Finally the information recording apparatus for recording partial information as claimed in claim 53 does not require the features of “an outputting device for **outputting the main information including a plurality of partial information** and **recording position information** showing a recording position of the partial information on the optical recording medium on which the partial information is to be recorded,... wherein in each session of outputting the whole of the same main information, the outputting device sequentially outputs the partial information and the recording position information in accordance with an order of recording or reproducing, and **wherein the recording position information comprises sector address information set in advance in the optical recording medium**” as recited in group I, and

“address information indicating a position on an information recording medium in which the partial information is to be recorded via network and an **address information** receiving device for receiving the address information corresponding to the partial information and a recording device for recording the partial information at a position on the information recording medium indicated by the address information” as recited in claim 49.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HELEN SHIBRU whose telephone number is (571)272-7329. The examiner can normally be reached on M-F, 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THAI Q. TRAN can be reached on (571) 272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/HELEN SHIBRU/
Examiner, Art Unit 2621
June 30, 2009

/Thai Tran/

Supervisory Patent Examiner, Art Unit 2621